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In re Application of YU et al  
U.S. Application No.: 09/744,788  
Int. Application No.: PCT/US99/17116  
Int. Filing Date: 28 July 1999  
Priority Date: 30 July 1998  
Attorney Docket No.: A2996A US  
For: ISOFORMS OF HUMAN CALCIUM  
SENSING RECEPTOR

DECISION ON PETITION

UNDER 37 CFR 1.47(a)

This is in response to applicant's "Renewed Petition Under 37 CFR 1.47(a)" filed 28 May 2002.

### **BACKGROUND**

On 28 July 1999, applicant filed international application PCT/US99/17116, which claimed priority of an earlier United States application filed 30 July 1998. A Demand for international preliminary examination, in which the United States was elected, was filed on 28 February 2000, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 30 January 2001.

On 30 January 2001, applicant filed national stage papers with the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 14 May 2001, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), indicating that an oath or declaration in compliance with 37 CFR 1.497 must be filed along with a surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty (30) months from the priority date.

On 24 January 2002, applicant filed a petition under 37 CFR 1.47(a) along with a declaration signed by two of the three joint inventors.

On 12 February 2002, this Office mailed a decision dismissing the 24 January 2002 petition on grounds that applicant had not adequately demonstrated the purported unavailability of the nonsigning inventor.

On 14 March 2002, applicant filed a renewed petition under 37 CFR 1.47(a).

On 28 March 2002, this Office mailed a decision dismissing the 14 March 2002 renewed petition on grounds that applicant had not adequately demonstrated the purported unavailability of the nonsigning inventor.

On 28 May 2002, applicant filed the present renewed petition under 37 CFR 1.47(a).

### **DISCUSSION**

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

Applicant has previously satisfied items (1), (3), and (4) above.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted which fully describes the exact facts which are relied on to establish that a diligent effort was made. . . . The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

The renewed petition states that joint inventor Larry Thrower cannot be located. The renewed petition states that several attempts to reach Mr. Thrower by mail on 03 May 2002 were unsuccessful (see affidavit of William Coppola, ¶¶2-6 and Exhibit B). Applicant has provided copies of returned envelopes which indicate that the letters could not be successfully delivered (see Exhibits C and E). Furthermore, applicant attempted to contact Mr. Thrower through joint inventor Richard Labaudiniere (see Exhibit A). Moreover, applicant unsuccessfully tried to obtain

a telephone number for Mr. Thrower (see Coppola's affidavit, ¶7, and the affidavit of Andrea Ryan, ¶4). Therefore, it can be concluded with reasonable certainty that Mr. Thrower cannot be found or reached after diligent effort.

### CONCLUSION

For the reasons above, the renewed petition under 37 CFR 1.47(a) is GRANTED.

This application has an international filing date of 28 July 1999 and a date under 35 U.S.C. 371 of 24 January 2002.

As set forth in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the nonsigning inventor at the last known address of record and will be published in the *Official Gazette*.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision.



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